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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 2003-0425 / 24061.102

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on September 21, 2009

Signature: Bonnie Boyle

Typed or printed name: Bonnie Boyle

Application Number	Filed
10/811007	March 25, 2009

First Named Inventor: Yu Jen Chen

Art Unit	Examiner
3623	Sterrett, Jonathan G.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 42,044
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

David M. O'Dell
Typed or printed name

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Telephone number

Sept. 21, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

PATENT
Customer No. 27683

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Yu Jen Chen	§	Atty Docket No.: 2003-0425 / 24061.102
	§	
	§	Customer Number: 42717
Application No.: 10/811,007	§	
	§	Examiner: Sterrett, Jonathan G.
Filing Date: March 25, 2004	§	
	§	Art Unit: 3623
Entitled: A Method and System for Providing an Inference Engine Including a Parameter-Based Cost Function to Evaluate Semiconductor Clients	§	
	§	Confirmation No.: 8989

Commissioner for Patents
Mail Stop: AF
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Madame:

I. INTRODUCTION

The present paper is being filed under the Official Gazette Notice of July 12, 2005, and in response to the final Office Action mailed July 28, 2009 ("Final Office Action"), in connection with the above-noted application. A Notice of Appeal with the proper fee is being filed concurrently with this paper. It is assumed that no additional fees are required, but if any additional fees are required, the Commissioner is hereby authorized to charge any fees, including those for any extensions of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

II. REASONS

A. Rejection of independent claims 1, 17, and 23 under 35 U.S.C. §103 over Brown

The Final Office Action maintained the rejection of independent claims 1, 17, and 23 under 35 U.S.C. § 103(a) over Brown, et al. ("A Centralized Approach to Factory Simulation," 1997, Future Fab International, pp.1-9, hereinafter referred to as "Brown"). Applicants submit that there is clear error at least with respect to the rejection of independent claims 1, 17, and 23 under 35 U.S.C. §103(a) over Brown, and respectfully traverse this rejection on the grounds that the Brown references is defective in establishing a prima facie case of obviousness with respect to independent claims 1, 17, and 23.

Independent claims 1, 17, and 23 each recite, "a virtual fab." The present Application teaches an exemplary embodiment of "a virtual fab" at least at Figure 3 and paragraphs 0038-0039. Figure 3 is reproduced below.

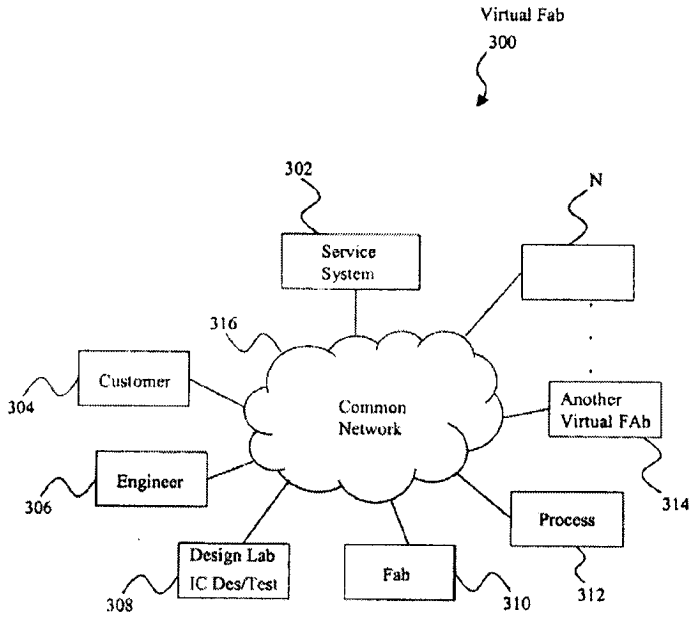

Fig. 3

Furthermore, the specification of present Application teaches the following regarding an exemplary embodiment of a "virtual fab": "The virtual fab 300 enables interaction among the

entities 302-312 for the purpose of IC manufacturing, as well as the provision of services. In the present example, IC manufacturing includes receiving a customer's IC order and the associated operations needed to produce the ordered ICs and send them to the customer, such as the design, fabrication, testing, and shipping of the ICs. One of the services provided by the virtual fab 300 may enable collaboration and information access in such areas as design, engineering, and logistics. For example, in the design area, the customer 304 may be given access to information and tools related to the design of their product via the service system 302. The tools may enable the customer 304 to perform yield enhancement analyses, view layout information, and obtain similar information. In the engineering area, the engineer 306 may collaborate with other engineers using fabrication information regarding pilot yield runs, risk analysis, quality, and reliability. The logistics area may provide the customer 304 with fabrication status, testing results, order handling, and shipping dates. It is understood that these areas are exemplary, and that more or less information may be made available via the virtual fab 300 as desired." Application, ¶¶ 0038-0039.

With respect to claim 1, the Examiner dismissed Applicants' arguments, as set forth in the response to the Office Action mailed January 5, 2009, that Brown fails to teach a "virtual fab." For example, the Office Action on page 3 alleges the following: "The applicant [in the response to the Office Action mailed January 5, 2009] relies on the exemplary discussion in the specification as to what a virtual fab entails. However, the examiner notes that the applicant has not invoked lexicography in the specification to set forth a definition as to what a 'virtual fab' is with the required clarity, deliberateness and precision."

A primary tenet of claim construction requires the Examiner to give patent claims "their broadest reasonable interpretation consistent with the specification." MPEP 2111 (emphasis added). The Federal Circuit's en banc decision in *Phillips v. AWH Corp.* expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard:

> The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367

> F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

415 F.3d at 1316, 75 USPQ2d at 1329. Here, Applicants are not trying to persuade the Examiner to import definitions from the specification into the claims in interpreting claim 1, but are respectfully requesting the Examiner to construe the term "virtual fab" in light of the specification as it would be interpreted by one of ordinary skill in the art.

Applicants submit that the Examiner's construction of the term "virtual fab" to read on the factory simulation models taught by Brown is inconsistent with the specification, and therefore is a clear error at least because the specification clearly teaches that a "virtual fab" enables interaction among real-world entities for the purpose of IC manufacturing and the provision of services. IC manufacturing, as defined in the specification, includes receiving a customer's IC order and the associated operations needed to physically produce the ordered ICs and send them to the customer. Thus, a "virtual fab," as taught by the specification, and as recited in claim 1, is not equivalent to the factory simulation models taught by Brown.

Applicants submit that Brown fails to teach, show, or even suggest a virtual fab as currently recited in independent claim 1. The Examiner conceded on page 3 of the Final Office Action that Brown merely teaches a factory simulation engine: "Brown teaches a simulation engine for simulating what happens in a factory (Brown is using the factory simulation engine to determine what happens when parameters in the factory simulation are changed before those parameters are done for real in the actual factory), Brown's factory simulation is a 'virtual fab' since Brown's factory is simulated (i.e. is virtual as opposed to real) and is a fabrication facility, i.e., a factory or fab." Final Office Action, p. 3 (emphasis added). However, the factory simulation engine taught by Brown fails to teach, show, or even suggest, "a virtual fab," as recited in claim 1.

Thus, Brown fails to teach, show, or even suggest a virtual fab, as recited in claim 1.

Accordingly, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met. Therefore, for at least the additional reasons set forth above, it is respectfully submitted that the rejection of claim 1, and all claims which depend therefrom, under 35 U.S.C. § 103 over Brown should also be reconsidered and withdrawn.

Independent claims 17 and 23 were also rejected under 35 U.S.C. §103(a) as being obvious over Brown. Similar to claim 1, claims 17 and 23 also recite a "virtual fab." The same arguments set forth above with respect to claim 1 apply equally to claims 17 and 23. Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met, and the rejection of claims 17 and 23, and all claims which depend therefrom, under 35 U.S.C. §103(a) should be withdrawn.

III. Conclusion

In view of the fact that there is at least one clear error in the rejections, as demonstrated above, it is apparent that the rejections of the pending claims under 35 U.S.C. § 103(a) are not supported by the cited references and should therefore be withdrawn. Accordingly, all of the pending claims in the application being in condition for allowance, such action is respectfully requested.

Respectfully submitted,

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